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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/540,877 | 06/27/2005 | Hiroyuki Kanza | 0020-5389PUS1 | 1761 |
| 2292 | 7590 | 12/13/2006 | | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| | | | EXAMINER KARIKARI, KWASI | |
| | | | ART UNIT | PAPER NUMBER |

2617

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/540,877

Applicant(s)

KANZA, HIROYUKI

Examiner

Kwasi Karikari

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/540,877.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/27/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 06/27/2005 is in compliance with the provision of 37 CFR 1.97, has been considered by the Examiner, and made of record in the application file.
2. Claim 2 has been canceled.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-10 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. The claimed subject matter in the instant application fails to define a result in the process that is being claimed. The Examiner has determined that claim 8 and the claims that depend thereof, fails to provide a practical application that produces a useful, tangible and concrete result. Claim 10 provides evidence that claim 8 constitute a disembodied computer algorithm.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6 rejected under 35 U.S.C. 102(b) as being anticipated by

Welling, Jr. et. al., (U.S 6, 181, 927), (hereinafter Welling).

Regarding **claim 1**, Welling discloses an information processor (= integration of BTS, BSC, MSC and SCP, see Fig. 1) comprising:

a situation acquiring means for acquiring situation information about a situation in which an operation has been performed (= information attribute includes time of call, location of call; and subscriber ID or call made by subscriber, see col. 4, lines 13-50);

a situation and operation storage means for storing the situation information acquired by the situation acquiring means and operation information about the operation performed then in an associated manner (= trigger database stores numbers and associated called number, see col. 4, lines 13-50);

a situation comparing means for comparing a current situation information piece with situation information pieces stored in the situation and operation storage means (= called number/ID is compared with number in database, see col. 4, lines 13-50);

a situation hierarchy storage means for storing at least the situation information acquired by the situation acquiring means in a hierarchical structure (= list of numbers are stored in the database, see col. 4, lines 13-50);

a broader concept searching means for searching for a broader concept common to two situation information pieces compared by the situation comparing means on a

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basis of the situation information of the hierarchical structure stored in the situation hierarchy storage means (called number is compared with special stored numbers, see col. 4, lines 13-50);

an operation procedure executing means for executing an operation procedure according to an operation information piece stored in the situation and operation storage means on a basis of a result of the comparison by the situation comparing means and a result of the search by the broader concept searching means (= matching and trigger functionality, see col. 4, lines 13-50); and

an operation adapting means for adapting an operation procedure to be executed by the operation procedure executing means to a current situation when, as a result of the search by the broader concept searching means, a broader concept of a situation information piece on the current situation agrees with that of a situation information piece stored in the situation and operation storage means (= execution of sponsored message if called number/ID is matched with number/ID in the database, see col. 3, line 56- col. 4, line 58 and col. 6, lines 53-67).

Regarding **claim 3**, as recited in claim 1, Welling discloses that the information processor comprising:

a communication means for communicating with apparatuses that have their respective unique addresses (= communication between the network terminal and caller 32, see col. 3, lines 24-64 and Figs. 1, 2a & 2b) and

wherein the situation acquiring means acquires a unique address of an apparatus targeted for communications as a constituent element of the situation information via the communication means (see col. 3, lines 6-64 and col. 2, lines 31-60).

Regarding **claim 4**, as recited in claim 3, Welling discloses the information processor, wherein when the unique address of the apparatus targeted for communications has been allocated by a server, the situation acquiring means acquires an IP address of the server via the communication means (see col. 3, lines 6-64 and col. 2, lines 31-60).

Regarding **claim 5**, as recited in claim 1, Welling discloses the information processor, comprising: a situation and operation inputting means for specifying, by a user, situation information and operation information to be stored in the situation and operation storage means (= IP 44 collects response from caller 32 and forward it to SCP, see col. 3, lines 6-13).

Regarding **claim 6**, Welling discloses a portable terminal comprising the information processor (= communication caller 32 in the system, see col. 3, lines 6-64) as claimed in claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lange et al. (U.S 6,704,564) (hereinafter Lange) in view of Welling, Jr. et. al., (U.S 6,181,927), (hereinafter Welling).

Regarding **claim 7**, Lange discloses an information processing system comprising a server (= service center 170) and a portable terminal (= communication device 110) to communicate with the server, wherein

the portable terminal (communication device 110) comprises:

a situation acquiring means for acquiring situation information about a situation in which an operation has been performed (= configuration signal that defines trigger conditions such as speed, temperature and location via sensor/data input, see col. 4, lines 9-24 and col. 6, lines 6-26);

a situation and operation storage means for storing the situation information acquired by the situation acquiring means and operation information about the operation performed then in an associated manner (= trigger signals are stored in memory 130 as history speed, see col. 4, line 43- col. 5, line 5 and col. 6, lines 7-33) and

a situation comparing means for comparing a current situation information piece with situation information pieces stored in the situation and operation storage means (Processor 290 parses and evaluates dynamic expression 261-63 for "true" result,

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see col. 6, lines 6-33);

an operation procedure executing means for executing an operation procedure according to an operation information piece stored in the situation and operation storage means on a basis of a result of the comparison by the situation comparing means and a result of the search by the broader concept searching means (see col. 6, lines 6-33 and col. 5, lines 28-63); and

an operation adapting means for adapting an operation procedure to be executed by the operation procedure executing means to a current situation when, as a result of the search by the broader concept searching means, a broader concept of a situation information piece on the current situation agrees with that of a situation information piece stored in the situation and operation storages means (message is sent of service center 170 if expression yield "true", see col. 5, line 28- col. 6, line 33); but fails specifically to disclose that the server comprises: a situation hierarchy storage means for storing the situation information acquired by the situation acquiring means in a hierarchical structure; and a broader concept searching means for searching for a broader concept common to two situation information pieces compared by the situation comparing means on a basis of the situation information of the hierarchical structure stored in the situation hierarchy storage means.

However, Welling teaches the server (integration of BTS, BSC, MSC and SCP, see Fig. 1) that comprises:

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a situation hierarchy storage means for storing the situation information acquired by the situation acquiring means in a hierarchical structure (= list of numbers are stored in the database, see col. 4, lines 13-50); and

a broader concept searching means for searching for a broader concept common to two situation information pieces compared by the situation comparing means on a basis of the situation information of the hierarchical structure stored in the situation hierarchy storage means (called number is compared with special stored numbers, see col. 4, lines 13-50).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Welling into the system of Lange for the benefit of achieving a system the includes the capability of transmitting messages to a subscriber station based on the location of the subscriber and other attributes of characteristics of the subscriber station (see Welling, col. 1, lines 25-63).

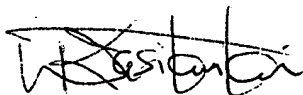
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kwasi Karikari
Patent Examiner.


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER